

Application Serial No. 09/533,361
Response to Office Action dated March 16, 2009

REMARKS/ARGUMENT

Claims 1 and 3 have been amended by incorporating the subject matter of claim 18 into them. Accordingly, claim 18 has been canceled.

The dependency of the remaining claims has also been amended as appropriate.

Composition claims 20-22, 30 and 34-47 have been canceled.

Claims 1-3, 18, 19 24-29, 31-33, 48 and 49 are currently pending.

Applicants thank Examiner Yu for the courtesy of discussing this case with their undersigned representative on June 24, 2009. The substance of this discussion is summarized and expanded upon in the remarks below.

The claims of this application as presented in the two independent claims are a method for reducing the signs of cutaneous aging and a method for reducing wrinkles using at least one grafted silicon polymer, which as described in the application provides a tightening or tensioning effect on the skin. Applicants have previously submitted two Declarations which have demonstrated that such polymers having a polysiloxane backbone grafted with a non-silicon organic monomer provided a surprising result in terms of tensioning effects.

In the Official Action, the Examiner has withdrawn the previous obviousness rejection combining Fox and Kumar. However, the Examiner now applies an obviousness rejection citing only the Kumar patent (US 5,468,477).

The Kumar patent describes grafted silicone polymers in a general manner and suggests that such polymers can be used in various cosmetic compositions including hair sprays and face creams (see column 30, example 27 for face cream; column 23, lines 60 for hair care compositions). Kumar also describes that compositions that contain the polymer

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provide moister barrier effects, water repellency, oil resistance and preventing the growth of bacteria.

The Examiner's basic position is that as Kumar describes the same polymers that could be used in cosmetic compositions it would have been reasonably expected to reduce the signs of cutaneous aging and/or reduce wrinkles when the cosmetic compositions, as Kumar suggests, would have been applied to the skin.

Applicants cannot agree with this position because the Examiner has not established nor does Kumar describe that the compositions would be used on skin having signs of cutaneous aging or specifically applying the composition to wrinkled skin.

Furthermore, to support this rejection, the Office Action has taken the position that because Kumar's film-forming polymers were known to have certain properties with respect to hair care, using such polymers to reduce signs of cutaneous aging would have been obvious. That is, the Office Action has apparently taken the position that Kumar's disclosing the use of film-forming polymers for treating hair would render obvious all other, completely different uses of such polymers. This is certainly not the law, nor could it possibly be the law -- under such an interpretation, method of use claims directed to novel uses of existing compounds would never be patentable because the compounds were already known. It is well-settled that new uses of existing compounds are entitled to patent protection. Such a novel use of known polymers is what the claims of the present application are directed to -- the pending claims directed to reducing cutaneous signs of aging cannot be taught or suggested by the applied art which is directed to completely different uses.

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In view of the above, Applicants respectfully submit that no *prima facie* case of obviousness exists.

However, even assuming a *prima facie* case of obviousness has been set forth, the surprising and unexpected results associated with the claimed invention are more than sufficient to rebut any such hypothetical *prima facie* case of obviousness. Specifically, as detailed in the Rule 132 declaration submitted with Applicants' September 20, 2006, response, invention compositions possessed significantly higher tensioning effect than comparative compositions, and this vast difference in tensioning effect among the different polymers was surprising and unexpected given the similarity of the compositions and the similarity of the moieties in the polymers.

The Rule 132 declaration submitted May 14, 2008, further demonstrates the superior properties associated with the claimed invention. This declaration, too, demonstrates that the invention polymers provide significant tensioning action.

In view of the above, Applicants respectfully submit that a sufficient showing of unexpected and surprising results has been made to overcome any hypothetical case of *prima facie* case of obviousness which may exist. Nothing in any of the applied art teaches or suggests using the effective amounts of the claimed polymers with the intent of reducing cutaneous signs of aging/wrinkles, let alone that the claimed polymers would possess surprising and unexpected properties in this regard.

The Examiner also criticizes the data provided in the previous Declaration as she believes that the results were expected from Kumar who teaches a higher tensile strength of his copolymers. Here the Examiner appears to ignore the fact that the Declarant in paragraph

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10 specifically says that this is an unexpected and surprising effect for tensioning skin.

It is legal error for the Office to dismiss a showing of unexpected results as flowing from or inherent in the Examiner's prior art construct (see In re Sullivan, 84 USPQ2d 1034 (Fed. Cir. 2007)).

In addition to their showing that there is no *prima facie* case, Applicants have shown an unexpected improvement. The Examiner has put forth no reasoning that would support a conclusion that, *looking forward*, such an improvement would have been expected from the combination of cited art. Rather, the Examiner looks backwards and concludes that because it is her opinion that the references present a *prima facie* case any property, benefit, or characteristic of the invention Applicant wishes to discuss in rebuttal is meaningless. This is improper and, at best, is a classic case of requiring comparison of the results of the invention with the results of the invention.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

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Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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